REMARKS/ARGUMENTS

This Amendment is submitted in response to the Office Action mailed April 7, 2009. Claims 2, 4-8, 39, 41-45, 80 and 81 were pending. In the Office Action:

1. Claim 2 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
2. Claims 2, 4, 39, 41, 80, and 81 were rejected under 35 U.S.C. § 112 as being indefinite; and
3. Claims 2, 4-8, 39, 41-45, 80 and 81 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Publication No. 2002/0013729 to Kida, *et al.*, (the "Kida application"), in view of U.S. Patent Publication No. 2003/0208560 to Inoue, *et al.* (the "Inoue application").

With this amendment, Claims 4, 7-8, 41, and 45 have been amended to address the rejections under § 112, Claims 4, 41, 80, and 81 have been amended to further distinguish over the Kida and Inoue applications, and Claims 2 and 39 have been canceled without prejudice. The cancellation of Claim 2 obviates the rejection under § 101 without admission as to its validity. It is believed that the amendments to the claims and the remarks provided below address the remaining rejections. **Claims 4-8, 41-45, and 80-81 are now pending.**

Claim Rejections - 35 U.S.C. § 112

Claims 4, 41, 80, and 81 were rejected under 35 U.S.C. § 112 as being indefinite for the use of the phrases "category judgment" and "handicap application."

The phrase "category judgment" strictly appeared in Claim 2, which has now been cancelled without prejudice. Claims 4, 7-8, 41, and 45 recite the phrase "category." With this Amendment, these claims have been amended to clarify the phrase as follows: "minimum unit category." These amendments are supported, *inter alia*, by the original specification at page 43, line 13 through to page 44, line 9, and original Claims 7, 18, 44 and 55. In order to provide strict antecedent basis for the phrase "each minimum unit category," the third paragraph of each of independent Claims 1 and 41 has been moved up, as indicated in the amendments. No

new matter has been entered by these amendments. It is respectfully submitted that the phrase "minimum unit category" is clearly defined in the original Specification at page 43, lines 13 through page 44, line 4, which is reproduced below for the convenience of the Examiner.

> "(Minimum Unit Category)
>
> In the present invention, the advertisement slots are not set in units of programs, but rather in numbers of viewings by a target viewer group. Specifically, viewers are classified into categories, based on criteria such as age, gender, family makeup, region of residence, hobbies, tastes, past actions and behavior. The advertiser, in placing an order, specifies the level of emphasis in the frequency of distributions to each of the desired categories. Furthermore, the present invention encompasses an embodiment where a unique category for each advertisement can be set up.
>
> FIG. 3 shows a general view of the emphasis in this free-category setting type of advertisement allocation method. The example shown in FIG. 3 is one in which each of the individual advertisers performs category division based on the criterion of viewer age. Both advertisers A and B set age categories, although the age steps are unique to each advertiser.
>
> In the present invention, a minimum unit category is determined which enables the category boundaries of both advertisers to be reflected, and the values of emphasis setting are assigned with respect to these minimum unit categories. Although this case describes division into age categories, it will be understood that obtainable viewer information items, such as gender and family makeup, can also be used as criteria for division into categories."

Accordingly, it is respectfully submitted the phrase "minimum unit category" meets the requirements of 35 U.S.C. § 112.

As to the phrase "handicap application," it is respectfully submitted that it is defined, *inter alia*, by the original abstract and the original Specification at page 7, lines 4-10 read in light of page 45, lines 4-15 and the handicap discussion at page 50, line 5 *et seq*. Accordingly, it is respectfully submitted the phrase "handicap application" meets the requirements of 35 U.S.C. § 112 by virtue of its definition in the original Specification.

Accordingly, it is believed that the Rejections under 35 U.S.C. § 112 have been addressed, and withdrawal of these Rejections is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 4-8, 41-45, 80 and 81 were rejected under 35 U.S.C. 103(a) as being obvious over the Kida application in view of the Inoue application. Each of independent Claims 4 and 41 has been amended to recite that the applied handicap is "based on the information about specification of increasing or decreasing," which finds antecedent basis earlier in the claims (now the third paragraphs of the claims). Support for these amendments is provided, *inter alia*, by the original Specification at page 45, line 4 through to page 49, line 20. No new matter has been entered. In a similar manner, each of independent Claims 80 and 81 has been amended to recite that the applied handicap is "based on information about specification of increasing or decreasing." These amendments are similarly supported by the original Specification, as indicated above. No new matter has been entered.

The Kida application only discloses that an advertisement schedule means sorts the user advertisement list in a display priority order after calculating a display priority of each advertisement (see paragraphs [0340]-[0341] of the Kida application).

The Inoue application only discloses that the computer repeats adjusting the level of the retrieval parameter, until the number of extracted records is equal to or larger than the value of a so-called "Maximum Number of Advertisement Data Items," before the random shuffling process is carried out to use the selected advertisements equally (see paragraphs [0165]-[0166] of the Inoue application). Since some of the advertisements are supposed to be rarely matched with average user's interests, the computer has extremely few opportunities to select such advertisements. As a result, the apparatuses disclosed by the Inoue application are very unlikely to achieve all the numbers of issued ad requested by advertisers within the planning time period in the system administrator's enthusiasm to avoid failing to "distribute advertisements that are in accord with uses' interests."

Accordingly, the Kida application fails to teach or suggest "a means for random extraction," and both of the Kida and Inoue applications fail to teach or suggest the "means for handicap application" recited by each of independent Claims 4 and 80, wherein the applied handicap is based on the "information about specification of increasing or decreasing," which causes a "deviation in the extraction probability distribution between each advertising list at each

random extraction," so as to select an advertisement corresponding to each viewer. Similarly, both of the Kida and Inoue applications fail to teach or suggest the actions of "applying handicap" recited by each of independent Claims 41 and 81, wherein the applied handicap is based on "information about specification of increasing or decreasing," which causes a "deviation in the extraction probability distribution between each advertising list at each random extraction," so as to select an advertisement corresponding to each viewer.

Because both of the Kida and Inoue applications fails to teach or suggest the "means for handicap application" recited by each of Claims 4 and 80, the *prima facie* combination of the Kida and Inoue applications cannot render either of Claims 4 and 80 obvious because the combination does not have all of the elements of the claim (M.P.E.P. § 2143.03, "All Claim Limitations Must Be Considered"). For the same reason, because both of the Kida and Inoue applications fails to teach or suggest the action of "applying handicap" recited by each of Claims 41 and 81, the *prima facie* combination of the Kida and Inoue applications cannot render either of Claims 41 and 81 obvious. For these reasons, it is respectfully requested that the Rejections of Claims 4, 41, 80, and 81 under 35 U.S.C. § 103(a) be withdrawn. Action to that end is respectfully solicited.

As further reasons for the patentability of Claims 4, 41, 80, and 81, it is respectfully submitted that the combination of the Kida and Inoue apparatuses would not work well without the incorporation of drastic and unobvious modifications, even if a person skilled in the art were to come up with the concept of such a combination. This is because the introduction of Inoue's random shuffling process into Kida's sorting process executed by his advertisement schedule means would ruin the primary goal and effect of Kida's invention of providing a configuration that "enables to this invention to distribute advertisements that are in accord with users' interests" (See paragraph [0427] of the Kida application). Accordingly, the combination of the Kida and Inoue applications proffered by the Rejection would render the Kida apparatus unsatisfactory for its intended purpose, and for this reason the proffered combination does not render independent Claims 4, 41, 80, and 81 obvious according to the standards set forth in M.P.E.P. §2143.01 (V) ("The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose"). Accordingly, Applicants respectfully submit that the

proffered combination cannot form the basis for a proper *prima facie* case of obviousness under the standards established by M.P.E.P. §2143.01 (V) and the case law upon which this section is based. For this reason as well, it is respectfully requested that the Rejections of Claims 1, 41, 80, and 81 under 35 U.S.C. § 103 be withdrawn. Action to that end is respectfully solicited.

Each of Claims 5-8 is dependent upon independent Claim 4, and therefore includes the distinguishing features of Claim 4, as described above. Therefore, it is respectfully submitted that each of Claims 5-8 is patentable over the applications to Kida and Inoue, taken alone or in combination, for at least the same reasons as discussed above for Claim 4. Similarly, each of Claims 42-45 is dependent upon independent Claim 41, and therefore includes the distinguishing features of Claim 41, as described above. Therefore, it is respectfully submitted that each of Claims 42-45 is patentable over the applications to Kida and Inoue, taken alone or in combination, for at least the same reasons as discussed above for Claim 41. Accordingly, it is respectfully submitted that Claims 5-8 and 42-45 are patentable in view of the relied-upon references, and it is respectfully requested that the Rejections of these claims under 35 U.S.C. § 103 be withdrawn. Action to that end is respectfully solicited.

Additional reasons for the patentability of Claims 4-8, 41-45, 80 and 81 exist, and Applicants reserve, without prejudice, the right to provide these reasons at a later date.

Further Amendments to Claims 42 and 80

In addition to the above-described amendments, Claims 42, 80, and 81 have been amended to correct for typographical errors. Also, the "means for managing the number of distributions" of Claim 80 has been amended to insert the sentence fragment "during a period of time for each information material, the actual number of distributions." With this amendment, the recitations of "the planned number of distributions," "the actual number of distributions," and "the remaining number of distributions" by Claim 80 follow the corresponding recitations of these elements by Claim 81. This amendment is supported, *inter alia*, by the original Specification at page 6, lines 23-29. Also, the addition of the word "distribution" after "extraction probability" in Claim 80 is supported, *inter alia*, by the original Specification at

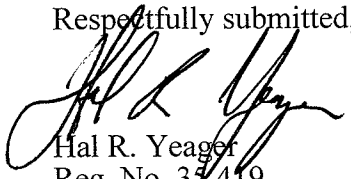
page 7, line 9. It is respectfully submitted that no new matter has been entered by these amendments.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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